



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,801	03/26/2004	Mark Flanagan	64435.000003	7169
21967 7590 04/15/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
EXAMINER				
TAYLOR, JOSHUA D				
ART UNIT		PAPER NUMBER		
2623				
MAIL DATE		DELIVERY MODE		
04/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,801

Applicant(s)

FLANAGAN ET AL.

Examiner

JOSHUA TAYLOR

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-43 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SF 100)
Paper No(s)/Mail Date 6/28/2004
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Inventor's Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 11 is objected to as it is not clear from where the VOD content is being uploaded. For the following rejection, it is assumed that it is being uploaded from the receiving station. Appropriate correction is required.

Claim 26 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 43 objected to because it does not make clear which claim it is dependent on. For the following rejection, examiner assumes it is dependent on claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, applicant refers to **“a control signal to the at least one receiving station for controlling initiation of the VOD content,”** but in claim 2 adds **“wherein the control signal comprises an interrupt command.”** If the signal is meant to initiate the VOD content, then it is unclear how that same signal can also interrupt it.

For the following rejection, examiner assumes that applicant is referring to transmitting multiple control signals, with the ability to both initiate and interrupt VOD content.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-9, 15, 20-22, 30-39 and 41-42 rejected under 35 U.S.C. 102(b) as being anticipated by Hoang (Pub. No.: US 2003/0051249).

Regarding claim 1, Hoang discloses: **A system for remotely controlling playback of VOD content, comprising: at least one receiving station for receiving and playing VOD content (Fig. 3, paragraph [0034], lines 3-13); and a control station for remotely controlling the VOD content over a communication network (paragraph [0083], lines 16-17), the control station**

selectively transmitting a control signal to the at least one receiving station for controlling initiation of the VOD content (paragraph [0083], lines 16-21). Hoang discloses that a control station can send out an emergency information bit in a data packet header (paragraph [0083], lines 16-17), which will cause the STB to interrupt what is being watched and instead display the emergency information. Therefore, the control station has the ability to control and initiate the VOD content.

Regarding claim 2, Hoang discloses: **The system of claim 1 wherein the control signal comprises an interrupt command for interrupting programming playing at the at least one receiving station** (paragraph [0083], lines 16-21).

Regarding claim 3, Hoang discloses: **The system of claim 2 wherein the interrupt command further comprises content to be played at the at least one receiving station** (paragraph [0083], lines 16-21).

Regarding claim 4, Hoang discloses: **The system of claim 2 wherein the interrupt is followed by content to be played at the at least one receiving station** (paragraph [0083], lines 16-21).

Regarding claim 8, Hoang discloses: **The system of claim 1 wherein the communications network comprises the Internet** (paragraph [0027], lines 26-29).

Regarding claim 9, Hoang discloses: **The system of claim 1 wherein the communications network comprises a cable communications network** (Fig. 1, element 120).

Regarding claim 15, Hoang discloses: **A system for initiating on-demand administration of video content, comprising: a receiving station having control means for controlling video content** (paragraph [0034], lines 3-13); **and a control station for interacting with the control means to remotely administer the video content** (paragraph [0083], lines 16-21).

Regarding claim 20, Hoang discloses: **A method for remotely controlling content, comprising: identifying at least one receiving station to control** (paragraph [0034], lines 3-13); **transmitting a control signal over a communications network to the at least one receiving station** (paragraph [0083], lines 16-21); **and controlling the content at the at least one receiving station** (paragraph [0083], lines 16-21). Hoang discloses that a control station can send out an emergency information bit in a data packet header (paragraph [0083], lines 16-17), which will cause the STB to interrupt what is being watched and instead display the emergency information. Therefore, the control station has the ability to control the content.

Regarding claim 21, Hoang discloses: **The method of claim 20 wherein controlling the content at the at least one receiving station comprises interrupting programming** (paragraph [0083], lines 16-21).

Regarding claim 22, Hoang discloses: **The method of claim 21 further comprising transmitting an alert notification** (paragraph [0083], lines 16-21).

Regarding claim 30, Hoang discloses: **A system for remotely controlling VOD, comprising: means for transmitting VOD content to at least one receiving station** (Fig. 1A, paragraph [0029], lines 7-11); **and means for remotely controlling the VOD content once it is received by the receiving station** (paragraph [0083], lines 16-21). Hoang discloses that a control station can send out an emergency information bit in a data packet header (paragraph [0083], lines 16-17), which will cause the STB to interrupt what is being watched and instead display the emergency information. Therefore, the control station has the ability to control the VOD content.

Regarding claim 31, Hoang discloses: **The system of claim 30 wherein the transmission means comprises a transmission module** (paragraph [0010], lines 1-3). The transmission means of Hoang inherently comprises a transmission module.

Regarding claim 32, Hoang discloses: **The system of claim 30 wherein the controlling means comprises a control module** (paragraph [0083], lines 16-21). The controlling means of Hoang inherently comprises a control module.

Regarding claim 33, Hoang discloses: **The system of claim 30 wherein the VOD content is transmitted over a communications network** (paragraph [0010], lines 1-3).

Regarding claim 34, Hoang discloses: **The system of claim 32 wherein the control modules controls the VOD content by transmitting a control signal** (paragraph [0083], lines 16-21).

Regarding claim 35, Hoang discloses: **The system of claim 34 wherein the control signal broadcasts a predetermined alert or notification message to the receiving station** (paragraph [0083], lines 16-21).

Regarding claim 36, Hoang discloses: **A method for controlling VOD content stored at a receiving station, comprising: sending a control signal over a communications network to a receiving station** (paragraph [0083], lines 16-21); **and controlling stored VOD content via the control signal** (paragraph [0083], lines 16-21).

Regarding claim 37, Hoang discloses: **A system for controlling VOD content stored at a receiving station, comprising: means for sending a control signal over a communications network to a receiving station** (paragraph [0083], lines 16-21); **and means for controlling stored VOD content via the control signal** (paragraph [0083], lines 16-21).

Regarding claim 38, Hoang discloses: **A system for controlling VOD content stored at a receiving station, comprising: means for receiving a control signal over a communications network from a control station** (paragraph [0083], lines 16-21); **and means for allowing the control signal to control stored VOD content** (paragraph [0083], lines 16-21).

Regarding claim 39, Hoang discloses: **The system of claim 1 wherein the VOD content may be encrypted and decrypted** (paragraph [0035], lines 1-6).

Regarding claim 41, Hoang discloses: **The system of claim 1 wherein the VOD content may be remotely requested** (paragraph [0012], lines 9-10).

Regarding claim 42, Hoang discloses: **The system of claim 1 further comprising a messaging module for permitting messaging over the communication network** (paragraph [0083], lines 16-21).

Claims 25-29 rejected under 35 U.S.C. 102(e) as being anticipated by Barton et al. (Pub. No.: US 2004/0268410).

Regarding claim 25, Barton discloses: **A method for controlling VOD content stored at a receiving station** (Barton, Fig. 2A, paragraph [0010], lines 1-3), **comprising: receiving a control signal over a communications network from a control station; and allowing the control signal to control stored VOD content** (Barton, paragraph [0040], lines 5-6).

Regarding claim 26, Barton discloses: **The method of claim 25 wherein the VOD content is stored at the receiving station** (Barton, paragraph [0040], lines 2-4).

Regarding claim 27, Barton discloses: **The method of claim 25 wherein the control signal administers the storage and cataloging of the VOD content** (Barton, paragraph [0040], lines 2-16).

Regarding claim 28, Barton discloses: **The method of claim 25 wherein the control signal updates the VOD content** (Barton, paragraph [0040], lines 5-6).

Regarding claim 29, Barton discloses: **The method of claim 25 wherein the control adds or deletes VOD content** (Barton, paragraph [0040], lines 5-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5-6 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over
Hoang (Pub. No.: US 2003/0051249) in view of Permut et al. (U.S. Patent 4,155,042).**

Regarding claim 5: **The system of claim 4 wherein the content comprises pre-recorded content to be played at the at least one receiving station** (Permut, column 3, lines 52-55).

Hoang discloses a system for interrupting content and inserting content to be played. However, Hoang does not disclose explicitly that the content be pre-recorded. Permut discloses a similar system for interrupting content and inserting live or pre-recorded input, so that the control station can insert whatever information is necessary. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow for the content being inserted to be

pre-recorded. Inserting whatever information was necessary would have been a highly desirable feature in the art, as it would allow for the control station to relay the appropriate message.

Regarding claim 6: **The system of claim 4 wherein the content comprises live content to be played at the at least one receiving station** (Permut, column 3, lines 52-55). Hoang discloses a system for interrupting content and inserting content to be played. However, Hoang does not disclose explicitly that the content be live. Permut discloses a similar system for interrupting content and inserting live or pre-recorded input, so that the control station can insert whatever information is necessary. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow for the content being inserted to be live. Inserting whatever information was necessary would have been a highly desirable feature in the art, as it would allow for the control station to relay the appropriate message.

Regarding claim 23: **The method of claim 22 wherein the alert notification comprises at least one of a pre-recorded or live message** (Permut, column 3, lines 52-55). Hoang discloses a system for interrupting content and inserting an alert notification. However, Hoang does not disclose explicitly that the alert notification be pre-recorded or live. Permut discloses a similar system for interrupting content and inserting live or pre-recorded input, so that the control station can insert whatever information is necessary. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow for the content being inserted to be pre-recorded or live. Inserting whatever information was necessary would have been a highly

desirable feature in the art, as it would allow for the control station to relay the appropriate message.

Claims 7, 10, 12-14, 16-19, 24 and 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Hoang (Pub. No.: US 2003/0051249) in view of Barton et al. (Pub. No.: US 2004/0268410).

Regarding claim 7: **The system of claim 1 wherein the communications network comprises a satellite communications network** (Barton, Fig. 1, paragraph [0016], lines 1-4), Hoang discloses a system for transmitting and controlling VOD content over a communications network. However, Hoang does not disclose the communications network comprising a satellite communications network. Barton discloses a VOD system which can be distributed over a satellite communications network, which is the medium over which many viewers receive their video content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the communications network comprise a satellite communications network in the system of Hoang. Increasing the networks by which the viewer can receive VOD content would have been a highly desirable feature in the art, as it would allow for more viewers to receive VOD content.

Regarding claim 10: **A system for transmitting and controlling VOD content, comprising: at least one receiving station for playing VOD content** (Hoang, paragraph [0034], lines 3-13), **the at least one receiving station comprising a downloading module for downloading the VOD content** (Barton, Fig. 2A, paragraph [0010], lines 1-3), **and at least one storage means for storing the VOD content** (Barton, Fig. 2A, paragraph [0010], lines 1-3); **a control station for transmitting the VOD content** (Hoang, paragraph [0027], lines 1-4), **the control station comprising a transmission module for transmitting the VOD content over a communications network** (Hoang, paragraph [0026], lines 1-4), **and a controlling module for selectively controlling the transmitted VOD content once it is received at the at least one receiving station** (Hoang, paragraph [0083], lines 16-21). Hoang discloses a system for transmitting and controlling VOD content. However, Hoang does not disclose having a set top box download and store the VOD content. Barton discloses a VOD system in which the VOD content can be stored locally at the set top box, thus increasing the options for the viewer to receive VOD content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a set top box capable of storing VOD content in the system of Hoang. Increasing the options by which the viewer can receive VOD content would have been a highly desirable feature in the art, as it would ensure that viewers received the requested VOD content a higher percentage of the time.

Regarding claim 12: **The system of claim 10 wherein the controlling module operates to interrupt ongoing programming at the least one receiving station** (Hoang, paragraph [0083], lines 16-21).

Regarding claim 13: **The system of claim 10 wherein the controlling module transmits at least one control signal to the at least one receiving station** (Hoang, paragraph [0083], lines 16-21).

Regarding claim 14: **The system of claim 13 wherein the control signal comprises an alert or notification message** (Hoang, paragraph [0083], lines 16-21).

Regarding claim 16: **The system of claim 15 wherein the control station interacts with the control means to remotely maintain a catalog of video content stored at the receiving station** (Barton, paragraph [0022], lines 6-8). Hoang discloses a system for transmitting and controlling VOD content. However, Hoang does not disclose having a catalog of video content stored at the receiving station. Barton discloses a VOD system in which a guide database could be downloaded to the set top boxes for browsing (Barton, paragraph [0022], lines 6-8), thus allowing the viewer to have more control over browsing the content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a set top box capable of storing a guide database in the system of Hoang. Increasing the control a viewer has over browsing content would have been a highly desirable feature in the art, as it would allow the user to more easily find a program, and thus more willing to purchase a program.

Regarding claim 17: **The system of claim 16 wherein the catalog of video content is updated, modified, verified, or revised by the control station** (Barton, paragraph [0022], lines 19-22).

Hoang discloses a system for transmitting and controlling VOD content. However, Hoang does not disclose having a catalog of video content stored at the receiving station, wherein the catalog is updated, modified, verified, or revised by the control station. Barton discloses a VOD system in which a guide database could be downloaded to the set top boxes for browsing (Barton, paragraph [0022], lines 6-8), and is updated by the control station, thus allowing the viewer to have more control over browsing the updated content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a set top box capable of storing an updatable guide database in the system of Hoang. Updating the guide so that the viewer had current information on what was available to watch would have been a highly desirable feature in the art, as it would allow the user to find a newly added program, and thus be able to purchase it.

Regarding claim 18: **The system of claim 15 wherein the control station interacts with the control means to remotely initiate the video content** (Hoang, paragraph [0083], lines 16-21).

Regarding claim 19: **The system of claim 18 wherein control station interrupts programming currently playing at the receiving station, and further initiates a designated alert or notification message** (Hoang, paragraph [0083], lines 16-21).

Regarding claim 24: **The method of claim 20 controlling the content at the at least one receiving station comprises administering or managing content stored at the at least one receiving station** (Barton, paragraph [0040], lines 5-6). Hoang discloses a system for remotely controlling VOD content. However, Hoang does not disclose administering or managing content stored at the receiving station. Barton discloses periodically updating the VOD content stored by the user to ensure that the user continues to have new content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the system manage content stored at the receiving station. Updating the content so that the viewer had current information on what was available to watch would have been a highly desirable feature in the art, as it would allow the user to watch a newly added program.

Regarding claim 43: **The system of claim wherein data relating to the VOD content is transmitted of the Public-Switched Telephone Network (PSTN)** (Barton, paragraph [0026], lines 5-9). Hoang discloses the system of claim 1, however, he does not disclose wherein data relating to the VOD content is transmitted of the Public-Switched Telephone Network (PSTN). Barton discloses that a plain old telephone system could be used as a return path for satellite transmission as it relates to the delivery of VOD content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a PSTN as a possible way to transmit data relating to the VOD content. Having a return path would allow the user to make requests for additional content, which would improve the ability of the system to deliver what the user wanted.

Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Hoang (Pub. No.: US 2003/0051249) in view of Barton et al. (Pub. No.: US 2004/0268410) as applied to claim 10 above, and further in view of Knox et al. (Pub. No.: US2003/0158928).

Regarding claim 11: The combined teachings of Hoang and Barton as a whole do not disclose **wherein the control station further comprises an upload module for uploading VOD content.** However, Know does (Knox, paragraph [0034], lines 6-14). Knox discloses uploading content from a remote location into a system for distribution over a communications network as a means of populating the system with content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow for the control station to have an upload module for uploading VOD content. Having a diverse selection of content would have been a highly desirable feature, as it would allow the viewers to have a better selection of VOD content to choose from, and thus make them more likely to purchase VOD content.

Claim 40 rejected under 35 U.S.C. 103(a) as being unpatentable over Hoang (Pub. No.: US 2003/0051249) in view of Knox et al. (Pub. No.: US2003/0158928).

Regarding claim 40: **The system of claim 1 wherein the VOD content may be remotely uploaded** (Knox, paragraph [0034], lines 6-14). Hoang discloses the system of claim 1, however, Hoang does not disclose wherein the VOD content may be remotely uploaded. Knox discloses uploading content from a remote location into a system for distribution over a communications network as a means of populating the system with content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow the user to remotely upload VOD content. Having a diverse selection of content would have been a highly desirable feature, as it would allow the viewers to have a better selection of VOD content to choose from, and thus make them more likely to purchase VOD content.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA TAYLOR whose telephone number is (571)270-3755. The examiner can normally be reached on 8am-5pm, M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Josh Taylor/

/Annan Q Shang/

Primary Examiner, Art Unit 2623